

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Tom MINER, *et al.*

Serial No.: 10/768,760

Filed: January 29, 2004

For: Intravenous Delivery System

Examiner: Osinski, Bradley J.
Group Art: 4111

Mail Stop Appeal Brief - Patents

Commissioner for Patents

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APPLICANTS' REPLY BRIEF

SIR:

This Reply Brief is in response to the Examiner's Answer dated March 16, 2010 and the Examiner's Supplemental Answer dated April 8, 2010. Pursuant to M.P.E.P. § 1208(I), the deadline for filing this Reply Brief is June 8, 2010.

REJECTIONS TO CLAIMS 1-42 AND 47-55 BASED ON DARLING, JR.

On page 13 of the Examiner's Answer, the Examiner states that "[o]ne of ordinary skill in the art would recognize that venting in a transverse direction is not dependent on the presence of every other structure of Darling, Jr." Essentially, the Examiner is impermissibly relying on just those portions of the Darling, Jr. reference which would support his position, and disregarding the rest. The Examiner, however, must consider the teachings of the prior art references *in their entireties*, including those portions which do not support the Examiner's conclusions. M.P.E.P. §2141.02(VI). "We must approach the issue of patentability in terms of what would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the *sum* of all the relevant teachings in the art, not in view of first one and then another of the

isolated teachings in the art.” *In re Kuderna*, 165 USPQ 575, 578-79 (C.C.P.A. 1970) (emphasis in original).

Here, the Examiner explicitly disregards those portions of the Darling, Jr. reference that would lead one of ordinary skill in the art away from the invention as claimed. This is impermissible hindsight reconstruction of the claimed invention. *Grain Processing Corp. v. Am. Maize-Products Co.*, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988) (In considering obviousness, “[c]are must be taken to avoid hindsight reconstruction by using ‘the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.’” – quoting *Orthopedic Equip. Co. v. United States*, 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983)).

The Examiner does not contest that the Darling, Jr. reference needs to be modified in order to meet the limitations of the claims, and offers only the conclusory statement that it would be obvious to do so. The Examiner offers no rationale or motivation for why one of ordinary skill in the art would take just those elements of Darling, Jr. as are necessary to meet the claim limitations and omit the rest. Thus, the Examiner has failed to make a *prima facie* case of obviousness and so has failed to establish that the invention as claimed in claims 1-42 and 47-55 is obvious from the applied art. Accordingly, withdrawal of all rejections based on Darling, Jr. is solicited.

REJECTION OF CLAIMS 43-46, 52 AND 53 BASED ON KNIGHTON

With respect to the invention of claims 43-48, 52 and 53, the Examiner has maintained that the Knighton reference teaches the claim limitation of a termination end vent plug that allows the passage of air therethrough until it is wetted, at which point it seals and prevents the further flow of air therethrough. The Examiner refers to col. 1 line 66 – col. 2, line 2 of Knighton to show this feature (Examiner’s Answer p. 14). However, the structure Knighton

discloses has two separate valves, one of which passes air therethrough and one of which passes liquid therethrough. This is discussed in applicants' opening Brief herein (pages 13-14) at length and that discussion will not be repeated here. Knighton has *no* disclosure of a wettable, sealable plug. The Examiner states (Examiner's Brief p. 14) that "Knighton ... discloses two vents, one of which (the one that allows air but not fluid flow) [that] allows air displaced by the flow of solution through the patient conduit to escape the termination end and prevents the escape of solution through said vent of said termination end cap upon wetting of the end vent plug by the solution." This is unsupported by the reference and is inconsistent with the teachings of Knighton, which requires the two vents to work *at all times* and are *never* described as being sealable upon wetting as is claimed. Given that making one end sealable and therefore inoperable would cause Knighton's debubbler to cease functioning, it is urged that the Examiner's reliance on Knighton is misplaced, and so the invention of claims 43-48, 52 and 53 is patentable over the combination of references applied by the Examiner.

For these reasons, as well as those set forth in applicant's opening Brief, the claimed invention is patentable over the art of record.

Respectfully submitted,
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